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Jocke
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February 7, 2005

Mail Stop Appeal Brief - Patents
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Re: **Application Serial No.:** 09/966,909
Appellants: Jay Paul Drummond, et al.
Filing Date: September 27, 2001
Confirmation No.: 5701
Title: AUTOMATED BANKING MACHINE
SYSTEM AND METHOD
Docket No.: D-1147 R1

Sir:

Please find enclosed the Brief of Appellants pursuant to 37 C.F.R. § 41.37 for filing in the above-referenced application.

Please charge the fee required with this filing (\$500) and any other fee due to Deposit Account 09-0428 of InterBold.

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Ralph E. Jocke
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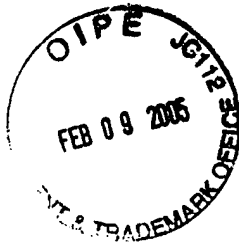
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CLEVELAND

330 • 722 • 6446
FACSIMILE

rej@walkerandjocke.com
E-MAIL

231 South Broadway, Medina, Ohio U.S.A. 44256-2601



D-1147 R1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:)	
Jay Paul Drummond, et al.)	
)	Art Unit 3624
Serial No.: 09/966,909)	
)	
Confirm. No.: 5701)	
)	
Filed: September 27, 2001)	Patent Examiner
)	Alain L. Bashore
For: AUTOMATED BANKING)	
MACHINE SYSTEM AND)	
METHOD)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 41.37

Sir:

The Appellants hereby submit their Appeal Brief pursuant to 37 C.F.R. § 41.37
concerning the above-referenced Application.

02/14/2005 MAHME1 00000032 090428 09966909

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(i)

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is
Diebold, Incorporated, an Ohio corporation.

(ii) RELATED APPEALS AND INTERFERENCES

Appellants believe that there are no related appeals or interferences pertaining to this matter.

(iii)

STATUS OF CLAIMS

Claims 1-20 are pending in the Application.

Claims rejected: 1-20

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claims objected to: none

Claims canceled: none

Appellants appeal the rejections of claims 1-20. These claim rejections were the only claim rejections present in the Office Action (“Action”) dated September 21, 2004, which was made non-final. Claims 1-17 have been twice rejected.

(iv)

STATUS OF AMENDMENTS

A non-final rejection was made September 21, 2004. No amendments to the claims were requested to be admitted after the non-final rejection.

(v) **SUMMARY OF CLAIMED SUBJECT MATTER**

Concise explanations of exemplary forms of the claimed invention:

With respect to independent claim 1

An exemplary form of the invention is related to automated banking machines such as automated teller machines (ATMs). This described exemplary form of the invention is directed to a method which comprises receiving with an automated banking machine (82) (Figure 4) at least one first wireless communication signal from a portable wireless device (Page 11, lines 10-16). Examples of such portable wireless devices discussed in the Specification include notebook computers (86), personal digital assistants (PDAs) and mobile phones (90) (Page 11, lines 16-17). The exemplary form of the method further comprises sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network (Page 12, lines 3-6). An example of a public wide area network described in the Specification includes the Internet (94). The exemplary form of the method further comprises receiving through operation of the banking machine at least one second network communication signal from the at least one server and sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal (Figures 4 and 5; Page 5, lines 1-14; Page 12, line 3 to page 15, line 21).

With respect to independent claim 6

Another exemplary form of the invention is directed to computer readable media bearing instructions which are operative in at least one a computer of an automated banking machine (82) to cause the automated banking machine to carry out a method. In this described exemplary form of the invention, the method comprises receiving with an automated banking machine (82) (Figure 4) at least one first wireless communication signal from a portable wireless device (Page 11, lines 10-16). Examples of such portable wireless devices discussed in the Specification include notebook computers (86), personal digital assistants (PDAs) and mobile phones (90) (Page 11, lines 16-17). The exemplary form of the method further comprises sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network (Page 12, lines 3-6). An example of a public wide area network described in the Specification includes the Internet (94). The exemplary form of the method further comprises receiving through operation of the banking machine at least one second network communication signal from the at least one server and sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal (Figures 4 and 5; Page 5, lines 1-14; Page 12, line 3 to page 15, line 21).

With respect to independent claim 7

Another exemplary form of the invention is directed to an apparatus (80) which comprises an automated banking machine (10, 82) including a computer (Figures 1 and 4). At

least one transaction function device (102) in the machine and in operative connection with the computer. Examples of transaction function devices discussed in the Specification include a sheet or cash dispenser (20), depositor (22), receipt printer (24), and card reader (26) (Page 9, lines 15-19). The apparatus further comprises an external network interface (92) in operative connection with the computer. Examples of an external network interface described in the Specification include a high speed network connection such as ISDN, ADSL, DSL, Cable Modem, T1, Fractional T1, or Frame Relay (Page 12, lines 5-6). The external network interface enables the machine to communicate in a wide area network (94). An example of a public wide area network discussed in the Specification includes the Internet (94) (Page 12, line 4). In this described exemplary form of the invention, the apparatus also includes a wireless access hub (84) in operative connection with the computer. The wireless hub enables the machine to communicate with at least one portable wireless device (Page 11, lines 14-16). Examples of portable wireless devices discussed in the Specification include notebook computers (86), personal digital assistants (PDAs) and mobile phones (90) (Page 11, lines 16-17). The machine is operative to enable the at least one portable wireless device to communicate in the wide area network (Page 5, lines 1-6; Page 12, lines 3-4).

With respect to independent claim 18

Another exemplary form of the invention is related to automated banking machines such as automated teller machines (ATMs). This described exemplary form of the invention is directed to a method which comprises providing, with an automated banking machine (82), a wireless network connection (84) between a portable wireless device and the automated banking

machine (Figure 4, Page 11, lines 13-16). Examples of portable wireless devices discussed in the Specification include notebook computers (86), personal digital assistants (PDAs) and mobile phones (90) (Page 11, lines 16-17). Examples of wireless network devices, interfaces, and systems for providing a wireless network connection between the ATM and portable wireless devices include an IEEE 802.11b, Bluetooth™, and IR based systems (Page 11, line 18 to Page 12, line 1). In this described exemplary form of the invention, the automated banking machine includes a cash dispenser (20) (Figure 1). In addition, the method comprises providing, with the automated banking machine, a network connection between the automated banking machine and a public wide area network (Page 12, lines 3-6). An example of a public wide area network described in the Specification includes the Internet (94). Examples of an external network interface (92) which provides the network connection to the public wide area network include a high speed network connection such as ISDN, ADSL, DSL, Cable Modem, T1, Fractional T1, or Frame Relay (Page 12, lines 5-6). The method further comprises determining with the automated banking machine that the portable wireless device is permitted to access the public wide area network (Page 12, line 9 to page 13, line 2). Responsive to this determination, the method comprises providing with the automated banking machine, the portable wireless device with access to the public wide area network through the wireless network connection with the automated banking machine (Page 5, lines 1-6).

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds to be reviewed in this appeal are:

Whether Appellants' claims 1-5, and 18-20 are unpatentable pursuant to 35

U.S.C. § 101 as being non-statutory;

Whether Appellants' claims 1 and 3-6 are unpatentable pursuant to 35 U.S.C. §

102(e) as being anticipated by Pare, Jr., et al., U.S. Patent No. 5,805,719 ("Pare");

Whether Appellants' claims 7-8, and 11-17 are unpatentable pursuant to 35

U.S.C. § 103(a) over Pare in view of Fischer, et al., U.S. Patent No. 5,978,650

("Fischer");

Whether Appellants' claims 9-10 are unpatentable pursuant to 35 U.S.C. § 103(a)

over Pare in view of Fischer as applied to claim 7 and further in view of Laybourn, et

al., U.S. Patent No. 6,480,710 ("Laybourn"); and

Whether Appellants' claim 2 is unpatentable pursuant to 35 U.S.C. § 103(a) over

Drummond, et al., U.S. Publication No. 2001/0014881 ("Drummond") in view of

Laybourn.

Additional Comment 1

The 35 U.S.C. § 102(e) rejection of claims 1-5, and 18-20 as being anticipated by Pare includes a typographical error. Appellants' Application claims the benefit of U.S. Provisional Application No. 60/237,812 filed October 4, 2000. The Pare reference issued over one year earlier on September 8, 1998. Appellants desire to proceed with their appeal to advance prosecution and to prevent unnecessary prosecution delay by the Office. Thus, for purposes of this appeal Appellants presume that the rejection of claims 1-5, and 18-20 was intended to be based on 35 U.S.C. § 102(b) and not 35 U.S.C. § 102(e).

Additional Comment 2

The 35 U.S.C. § 103(a) rejection of claim 2 over Drummond in view of Laybourn may be an error on the part of the Office. As shown in Applicant's Response to the Office Action dated February 13, 2004, the Drummond reference does not qualify as prior art. In the present Action, new grounds of rejection were applied in which Drummond has been replaced with Pare for all of the rejections except for claim 2. In addition, the arguments presented by the Action to support the rejection of claim 2 do not refer to Drummond but rather discuss the teachings of Pare, Fischer, and Laybourn.

Appellants desire to proceed with their appeal to advance prosecution and to prevent unnecessary prosecution delay by the Office. Thus, for purposes of this appeal Appellants presume that the rejection of claim 2 over Drummond in view of Pare is a typographical error. The Appellants presume that the 35 U.S.C. § 103(a) rejection of claim 2 was intended to be based on Pare in view of Laybourn or Pare in view of both Fischer and Laybourn. Appellants

reserve all rights to amend their arguments, including the filing of a Supplemental Appeal Brief, if their presumption is incorrect.

Additional Comment 3

In the Action, there appears to be no argument presented by the Office to support the rejection of claims 9-10 pursuant to 35 U.S.C. § 103(a) over Pare in view of Fischer as applied to claim 7 and further in view of Laybourn. However, the rejections of claims 9-12 and claim 2 are both listed under item number “7” in the Action.

Appellants desire to proceed with their appeal to advance prosecution and to prevent unnecessary prosecution delay by the Office. Thus, for purposes of this appeal Appellants presume the arguments presented by the Office in support of the rejection of claim 2 may have been intended to support the rejections of claims 9 and 10 as well. Appellants reserve all rights to amend their arguments, including the filing of a Supplemental Appeal Brief, if their presumption is incorrect.

(vii)

ARGUMENT

Pair (U.S. Patent No. 5,805,719)

Pair is directed to a system for identifying individuals for purpose of performing financial transactions and non-financial transmissions, which can accommodate large numbers of users. The system includes a data processing center (1) connected to various terminals (2) through various types of communications means (3) (Figure 1; Column 12, lines 28-33). The terminals may include a biometrics input device (12) (Figure 3; Column 12, line 48). As shown in Figure 1, one of the terminals (2) may include an ATM.

Fischer (U.S. Patent No. 5,978,650)

Fischer is directed to a transmission system (10) which provides bidirectional transmission of data between a central hub (12) and a number of subscribers (14, 14b) (Figure 1; Column 3, lines 8-13). Fisher discloses that the central hub (12) may communicate over any appropriate communication link such as wireless, including satellite and microwave (Column 3, lines 34-36).

Laybourn (U.S. Patent No. 6,480,710)

Laybourn is directed to a system (a) for managing a wireless prepaid service which includes a combination of networked workstations and servers. The system is accessible via wireless devices (10) such as mobile phones, fixed phones or a communication network such as the Internet (Figure 1; Column 2, lines 27-46).

The 35 U.S.C. § 101 Rejections

Claims 1-5 and 18-20 were rejected under 35 U.S.C. § 101 as non-statutory because the method claims as presented do not claim a technological basis. This rejection is respectfully traversed.

Claim 1 (grouped with claims 2-5)

The Action states that claim 1 is non-statutory because the method claim as presented does not claim a “technological basis.” The Action further states that without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S. C: § 101. The Action also states that in contrast, a method claim that includes in the preamble and body of the claim structural / functional interrelationships that are solely by computer (and non-trivial) are considered to have a technological basis. The Action indicates that the content and reasoning for this rejection is based on *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001). To further clarify the rejection the Action also states that “The preamble of claims 1 and 18 do not have a technical basis.”

Applicants respectfully disagree with these assertions. *Ex parte Bowman* does not support the alleged reasoning by which the Action has based the rejection. In this unpublished and non-precedential opinion, the Board of Patent Appeals and Interferences ruled that a method of evaluating an intangible asset by performing various steps of establishing variables, scoring performance criteria statements, and physically plotting a point on a chart failed to recite statutory subject matter because it did not fall within the definition of “technological arts.” The

Board reasoned that the invention was “nothing more than an abstract idea which is not tied to any technological art, environment, or machine and is not a useful art as contemplated by the Constitution of the United States.” The Board further noted that the “physical aspects of claim 1, which are disclosed to be nothing more than a human manually drawing a chart and plotting points on this chart, do not automatically bring the claimed invention within the technological arts.” *Ex parte Bowman* at 1671. The opinion does not use the phrase “technological basis,” nor does the opinion suggest that a preamble of a claim requires a “technical basis.”

Claim 1 includes a preamble which recites a “A method comprising.” Following the preamble is a series of steps labeled (a) through (d). Chapter 35 Section 101 of the United States Code only permits patents to be granted for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The term “process” as defined in 35 U.S.C § 100 means process, art or method, and includes new use of a known process, machine, manufacture, composition of matter, or material. Thus claim 1 falls into the statutory category of a process.

As discussed under MPEP 2106 IV B 2 (b) a claim that requires one or more acts to be performed defines a process. Appellants claim 1 is directed to the operation of an automated banking machine, which is disclosed in the Specification to include a computer (Page 3, lines 18-22). Under MPEP 2106 IV B 2 (b), to be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Claim 1 (as well as claims 2-5) clearly satisfies this requirement for a statutory process. For example step (b) of claim 1 recites a physical transformation outside a computer in which: through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal (received in step (a) from a portable wireless device) is sent to at least one server in operative connection with the banking machine through a wide area network. A practical application for this step in the technological arts is discussed in the Specification at page 4, lines 1-6, where the Specification states that:

In some exemplary embodiments an automated banking machine may be adapted to provide portable wireless devices with access to a public or private wide area network in operative connection with the machine. In such embodiments, an exemplary wireless network interface of the machine may include a wireless hub, router or gateway device that is selectively operative to give portable wireless devices fee based access to a wide area network such as the Internet.

Thus, the steps recited after the preamble of claim 1, recite statutory subject matter. Further, Appellants respectfully submit that the preamble “A method comprising” accurately defines the statutory category of a process for which the steps which follow the preamble correspond thereto.

The assertion in the Action that “[w]ithout a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea” is not a valid characterization of the steps which follow the preamble in claim 1. For example, how can the recited step (b) of:

sending through operation of the banking machine at least one first
network communication signal corresponding to the at least one first
wireless communication signal, to at least one server in operative
connection with the banking machine through a wide area network

involve no more than a manipulation of an abstract idea? With respect to the Action's reliance on *Ex parte Bowman*, how can this step involving the operation of a banking machine be interpreted as being directed to "nothing more than a human making mental computations?" *Ex parte Bowman* at 1671. Step (b) (as well as steps a, d and c) clearly define method steps which involve physical transformations outside a computer and cannot reasonably be interpreted as no more than a manipulation of an abstract idea.

With respect to the Action's assertions that the preamble of claim 1 has no technical basis, there are some non-U.S. countries (e.g., Russia and India) which do require a preamble of a claim to describe in detail the purpose of the recited invention. However, the Action has failed to show any legal basis such as rules promulgated under 35 U.S.C. § 101 which requires the asserted "technical basis" be included in a preamble of a U.S. claim. Further, nowhere in the unpublished and non-precedential *Ex parte Bowman* opinion is there discussed the requirement for a "technical basis" in the preamble of a claim. In addition, a rudimentary search for granted U.S. patents has revealed that the Office granted over 1,000 U.S. patents in 2004 in which claim 1 begins with the preamble "A method comprising:" Thus the continued issuance of U.S. patents with "A method comprising:" preamble, further highlights the absence of any rule prohibiting the use of such preambles under 35 U.S.C. § 101. A copy of the first page of a printout of this search is attached in the Evidence Appendix.

Appellants respectfully submit that placing structural or functional limitations in the preamble of claim 1 is not required to enable claim 1 to satisfy the statutory requirements of 35 U.S.C. § 101.

Claim 18 (grouped with claims 19-20)

Appellants discussion of 35 U.S.C. § 101 with respect to claim 1 is incorporated herein by reference. Appellants respectfully submit that claim 18 (as well as claims 19-20 which depend therefrom) satisfy the statutory requirements of 35 U.S.C. § 101. For example, step (d) of claim 18 recites a physical transformation outside a computer in which: responsive to (c), the automated banking machine provides the portable wireless device with access to the public wide area network through the wireless network connection with the automated banking machine. A practical application for this step in the technological arts is discussed in the Specification at page 4, lines 1-6.

The assertion in the Action that “[w]ithout a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea” is not a valid characterization of the steps which follow the preamble in claim 18. Step (d) (as well as steps a, b and c) clearly defines a method step which involve physical transformations outside a computer and cannot reasonably be interpreted as no more than a manipulation of an abstract idea.

Applicants respectfully submit that placing structural or functional limitations in the preamble of claim 18 are not required to enable claim 18 to satisfy the statutory requirements of 35 U.S.C. § 101.

The 35 U.S.C. § 102 (e) Rejections

The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is “necessarily present” in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999). It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

Rejection under 35 U.S.C. § 102(e) or 35 U.S.C. § 102(b) over Pare

Claims 1 and 3-6 were rejected under 35 U.S.C. § 102(e) as being anticipated by Pare.

These rejections are respectfully traversed.

As discussed previously, for purposes of this appeal Appellants presume that the rejection of claims 1-5, and 18-20 was intended to be based on 35 U.S.C. § 102(b) and not 35 U.S.C. § 102(e). The presumed 35 U.S.C. § 102(b) rejections are respectfully traversed as well.

Claim 1

Claim 1 is an independent claim directed to a method. The Action asserts that Pare discloses a method and apparatus including an automated banking machine with cash dispenser, portable wireless device with memory, receiving and sending wireless communication signals to and from the machine and device including RF via Internet and server. The Action further asserts that the “signals may include data reprehensive of a financial account (fig 1)” [sic].

Applicants disagree. Pare is directed to a data processing center (1) connected to various terminals (2) (Figure 1; Column 12, lines 28-31). The terminals include a Biometric Input Apparatus (BIA) which is a combination of hardware and software whose job is to gather, encode, and encrypt biometric input for use in individual identification. As shown in Figure 1, the terminals (2) may include an ATM (“Automated Teller Machinery”) (Column 26, lines 56-58) which is shown connected to the data processing center through an ATM network. However, nowhere does Pare disclose or suggest:

- receiving with an automated banking machine at least one first wireless communication signal from a portable wireless device.

Pare does not disclose or suggest a portable wireless device which sends a wireless communication signal to an automated banking machine such as an ATM. In Pare an ATM may be modified to include a BIA. However, Pare specifically teaches that BIA devices are contained within the physical enclosure of the terminal itself (Column 14, lines 2- 4; Column 85, lines 16- 19). Pare does not disclose or suggest that an automated banking machine such as an ATM receives a wireless communication signal from a BIA or receives a wireless communication signal from a portable wireless device.

In addition, nowhere does Pare disclose or suggest:

- sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server.

Further nowhere does Pare disclose or suggest:

- receiving through operation of the banking machine at least one second network communication signal from the at least one server; and
- sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal.

Nowhere in Figure 1 or anywhere else in Pare, is there disclosed or suggested “receiving and sending wireless communication signals to and from” an automated banking machine as asserted in the Action. Further, nowhere does Pare disclose or suggest receiving and sending wireless communication signals between an automated banking machine and portable wireless device.

Pare does not disclose each and every element, relationship, and step of the claimed invention arranged in the manner recited in the claims, as is required to sustain the objection. Hence, Appellants' claim 1 patentably distinguishes over the Pare reference.

Claim 3

Claim 3 depends from claim 1, Pare does not disclose or suggest an automated banking machine which dispenses cash and receives a wireless communication signal from a portable wireless device. Thus, Pare does not anticipate claim 3.

Claim 4

Claim 4 depends from claim 1. Pare does not disclose or suggest an automated banking machine which receives a wireless communication signal from a portable wireless voice communication device. Further, Pare does not disclose or suggest sending through operation of the automated banking machine a wireless communication signal to the portable wireless voice communication device. Thus, Pare does not anticipate claim 4.

Claim 5

Claim 5 depends from claim 4. Pare does not disclose or suggest modifying data representative of cash value in a memory of a portable wireless voice communication device responsive to operation of an automated banking machine. Thus, Pare does not anticipate claim 5.

Claim 6

Claim 6 is an independent claim directed to computer readable media bearing instructions which are operative in at least one computer to cause an automated banking machine to carry out a method. As discussed previously, Pare is directed to a data processing center (1) connected to various terminals (2) (Figure 1; Column 12, lines 28-31). The terminals include a Biometric Input Apparatus (BIA) which is a combination of hardware and software whose job is to gather, encode, and encrypt biometric input for use in individual identification. As shown in Figure 1, the terminals (2) may include an ATM (“Automated Teller Machinery”) (Column 26, lines 56-58) which is shown connected to the data processing center through an ATM network. However, nowhere does Pare disclose or suggest computer readable media bearing instructions which are operative in at least one computer to cause an automated banking machine to carry out the method step of:

- receiving with the automated banking machine at least one first wireless communication signal from a portable wireless device.

Pare does not disclose or suggest a portable wireless device which sends a wireless communication signal to an automated banking machine such as an ATM. In Pare an ATM may be modified to include a BIA. However, Pare specifically teaches that BIA devices are contained within the physical enclosure of the terminal itself (Column 14, lines 2- 4; Column 85, lines 16-19). Pare does not disclose or suggest that an automated banking machine such as an ATM receives a wireless communication signal from a BIA or receives a wireless communication signal from a portable wireless device.

In addition, nowhere does Pare disclose or suggest computer readable media bearing instructions which are operative in at least one computer to cause an automated banking machine to carry out the method step of:

- sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server.

Further, nowhere does Pare disclose or suggest computer readable media bearing instructions which are operative in at least one computer to cause an automated banking machine to carry out the method steps of:

- receiving through operation of the banking machine at least one second network communication signal from the at least one server; and
- sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal.

Nowhere in Figure 1 or anywhere else in Pare, is there disclosed or suggested “receiving and sending wireless communication signals to and from” an automated banking machine as asserted in the Action. Further, nowhere does Pare disclose or suggest receiving and sending wireless communication signals between an automated banking machine and portable wireless device. Pare does not disclose each and every element, relationship, and step of the claimed invention arranged in the manner recited in the claims, as is required to sustain the objection. Hence, Appellants’ claim 6 patentably distinguishes over the Pare reference.

The 35 U.S.C. § 103 (a) Rejections

The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

Rejection under 35 U.S.C. § 103(a) over Pare in view of Fischer

Claims 7-8 and 11-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pare in view of Fischer. These rejections are respectfully traversed.

Claim 7

Claim 7 is an independent claim directed to an apparatus. The apparatus comprises an automated banking machine including a computer and a wireless access hub in operative connection with the computer. The Action acknowledges that Pare does not disclose a wireless access hub. However, to overcome the admitted deficiencies of Pare, the Action asserts that Fischer discloses a wireless hub (Column 3, lines 30-40) and that it would have been obvious to one with ordinary skill in the art to include a wireless hub because Fischer teaches a hub as providing a pipeline for wireless communications of a wireless network (Column 3, line 26).

Applicants disagree. Fischer discloses a central hub (12) which corresponds to a transceiver for providing bidirectional transmission of data with a number of subscribers (Figure 1; Column 8-14). Fisher discloses that the central hub (12) may communicate over any appropriate communication link such as wireless, including satellite and microwave (Column 3, lines 34-36). However, Fischer does not disclose or suggest that its central hub is in operative connection with an automated banking machine.

Fisher discusses Asynchronous Transfer Mode (acronym “ATM”) technology (Column 1, line 19) which is a type of network technology. However, Asynchronous Transfer Mode network technology is not analogous to and does not suggest to one skilled in the art an Automated Teller Machine (also acronym “ATM”). Thus, nowhere in Fischer is there disclosed or suggested an automated banking machine such as an automated teller machine in operative connection with Fisher's central hub or a wireless access hub as recited in claim 7. Further, the Action has failed to show where Pare or Fischer or any other reference provides a prior art teaching, suggestion or motivation to modify the Automated Teller Machinery (“ATM”) disclosed in Pare to include the central hub (12) disclosed in Fischer. As discussed previously, Pare does not disclose an automated banking machine capable of wireless communication with portable wireless devices. Thus, how can it be obvious to one with ordinary skill in the art to include the central hub of Fisher in Pare when Pare does not disclose or suggest any need for an ATM to communicate wirelessly or otherwise with a portable wireless device?

Neither Pare nor Fisher disclose or suggest:

- wherein the wireless hub enables the machine to communicate with at least one portable wireless device.

Nowhere in Pare or Fischer is there disclosed or suggested an automated banking machine which communicates with a portable wireless device either with or without the machine using a wireless hub.

Also, neither reference discloses or suggests:

- wherein the machine is operative to enable the at least one portable wireless device to communicate in the wide area network.

Nowhere in Pare or Fisher is there disclosed or suggested an automated banking machine which enables communications between a portable wireless device and a wide area network.

Appellants respectfully submit that the Office has not established *prima facie* obviousness. Pare and Fisher do not disclose or suggest each and every element, relationship and step of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Nor has the Office cited any other prior art which shows the features and relationships missing from Pare and Fisher. Nor is there any prior art teaching, suggestion, or motivation cited for modifying Pare in view of Fischer so as to produce the claimed invention. Further, it would not have been obvious to one having ordinary skill in the art to have modified Pare and Fisher to have produced the claimed invention. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 7 is improper and should be withdrawn.

Claim 8

Claim 8 depends from claim 7. Neither Pare nor Fischer discloses or suggests an automated banking machine with a cash dispenser and a wireless access hub. Further, neither reference discloses or suggests that the machine with the cash dispenser is operative to communicate with at least one portable wireless device and enable the portable wireless device to communicate in the wide area network. Thus, the Office has not established *prima facie* obviousness with respect to claim 8.

Claim 11

Claim 11 depends from claim 7. Neither Pare nor Fischer discloses or suggests an automated banking machine which is operative to communicate with a portable wireless device and enable the portable wireless device to communicate in the Internet. Thus, the Office has not established *prima facie* obviousness with respect to claim 11.

Claim 12

Claim 12 depends from claim 8. Neither Pare nor Fischer discloses or suggests a computer of an automated banking machine which is operative to cause cash to be dispensed by a cash dispenser in the machine responsive to an input to a portable wireless device. Thus, the Office has not established *prima facie* obviousness with respect to claim 12.

Claim 13

Claim 13 depends from claim 7. Neither Pare nor Fischer discloses or suggests an automated banking machine which is operative to communicate with a wireless device that includes a data store with data representative of monetary value. Thus, the Office has not established *prima facie* obviousness with respect to claim 13.

Claim 14

Claim 14 depends from claim 13. Neither Pare nor Fischer discloses or suggests a computer of an automated banking machine which is operative to cause modification of data

representative of monetary value included in a data store of a portable wireless device. Thus, the Office has not established *prima facie* obviousness with respect to claim 14.

Claim 15

Claim 15 depends from claim 14. Neither Pare nor Fischer discloses or suggests a computer of an automated banking machine which is operative to cause modification of data representative of monetary value included in a data store of a portable wireless voice communication device. Thus, the Office has not established *prima facie* obviousness with respect to claim 15.

Claim 16

Claim 16 depends from claim 7. Neither Pare nor Fischer discloses or suggests an automated banking machine with a wireless access hub that is adapted to provide RF communication with a portable wireless device. Thus, the Office has not established *prima facie* obviousness with respect to claim 16.

Claim 17

Claim 17 depends from claim 16. Neither Pare nor Fischer discloses or suggests an automated banking machine with a wireless access hub that is adapted to provide RF communication over relatively short distance with a portable wireless device. Thus, the Office has not established *prima facie* obviousness with respect to claim 17.

Rejection under 35 U.S.C. § 103(a) over Pare in view of Fischer and Laybourn

Claims 9-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pare in view of Fischer as applied to claim 7 and further in view of Laybourn. These rejections are respectfully traversed.

As discussed previously, there appears to be no argument presented by the Office in the Action to support the rejections of claims 9-10 pursuant to 35 U.S.C. § 103(a) over Pare in view of Fischer as applied to claim 7 and further in view of Laybourn. For purposes of this appeal, Appellants presume the arguments presented by the Office in support of the rejection of claim 2 may have been intended to support the rejections of claims 9 and 10 as well. Appellants reserve all rights to amend their arguments, including the filing of a Supplemental Appeal Brief, if their presumption is incorrect.

Claim 9

Claim 9 depends from claim 7. With respect to claim 2, the Office admits that neither Pare nor Fischer discloses or suggests a usage fee or a fee charged responsive to a device enabled to communicate with a network. To overcome the admitted deficiencies in Pare and Fischer, the Action asserts that Laybourn discloses a fee charged responsive to a device enabled to communicate with a network (Column 1, lines 18-25) and that it would have been obvious to one with ordinary skill in the art to include a fee charged responsive to a device enabled to communicate with a network because Laybourn teaches such is conventional in the wireless art (Column 1, lines 20-1).

Appellants disagree. Laybourn discusses that subscribers of wireless phone services pay a monthly subscriber fee for access to a wireless service (Column 1, lines 18-22). Laybourn does not disclose or suggest an automated banking machine and does not disclose or suggest wireless communication between an automated banking machine and a portable wireless device. Also, as discussed previously, Pare does not disclose or suggest an ATM which communicates wirelessly or otherwise with a portable wireless device. Thus, how can it be obvious to one with ordinary skill in the art to include subscriber fees for wireless phone service from Laybourn in the ATM of Pare, when Pare does not teach or suggest any need to provide wireless services to a phone or any other portable wireless device from an ATM?

The Action has failed to show where Pare, Fischer, or Laybourn or any other reference provides a prior art teaching, suggestion or motivation to modify the ATM discussed in Pare to cause a fee to be charged to an account responsive to a portable wireless device being enabled to communicate in a wide area network.

Further, nowhere does Pare, Fisher, and Laybourn disclose or suggest a computer in an automated banking machine which:

- is adapted to receive information representative of an account from the at least one portable wireless device

Appellants respectfully submit that the Office has not established *prima facie* obviousness. Pare, Fisher and Laybourn do not disclose or suggest each and every element, relationship and step of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Nor has the Office cited any other prior art which shows the features and relationships missing from Pare, Fisher, and Laybourn. Nor is there any prior art

teaching, suggestion, or motivation cited for modifying Pare in view of Fischer and Laybourn so as to produce the claimed invention. Further, it would not have been obvious to one having ordinary skill in the art to have modified Pare, Fisher, and Laybourn to have produced the claimed invention. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 9 is improper and should be withdrawn.

Claim 10

Claim 10 depends from claim 9. Pare, Fischer, and Laybourn do not disclose or suggest that responsive to a portable wireless device being enabled to communicate in a wide area network, a computer of an automated banking machine is operative to cause a fee to be charged to an account through communication with a host banking system. Thus, the Office has not established *prima facie* obviousness with respect to claim 10.

Rejection under 35 U.S.C. § 103(a) over Drummond (or Pare) in view of Laybourn (or Laybourn and Fischer)

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond in view of Laybourn. This rejection is respectfully traversed.

As indicated on page 1 of the Specification and on the Official Filing Receipt, the present application is entitled to (and claims the benefit of) the October 4, 2000 filing date of provisional application serial No. 60/237,812. The filing date for this provisional application is earlier than the August 16, 2001 publication date of Drummond. Thus, Drummond cannot constitute prior art with respect to the present invention pursuant to 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a).

Further, inventors for the present application, namely Jay Paul Drummond and Mark D. Smith are among the inventors for the Drummond reference. Thus the Drummond reference will not qualify as prior art under 102 (e). In addition, the present application and the Drummond reference, at the time the invention of the present Application was made, were owned by the same entity or subject to an obligation of assignment to the same entity, namely Diebold, Incorporated. It follows that under 35 U.S.C. § 103(c) the Drummond reference is also disqualified from being used in a rejection under 35 § U.S.C. 103(a) against the claims of the present application.

However, as discussed previously, Appellants presume that the rejection based on Drummond was a typographical error and that the Office intended the rejection of claim 2 to be based on Pare in view of Laybourn or Pare in view of both Fischer and Laybourn. Thus, these presumed rejections are respectfully traversed as well.

Claim 2

Claim 2 depends from claim 1. The Office admits that neither Pare nor Fischer discloses or suggests a usage fee or a fee charged responsive to a device enabled to communicate with a network. To overcome the admitted deficiencies in Pare and Fischer, the Action asserts that Laybourn discloses a fee charged responsive to a device enabled to communicate with a network (Column 1, lines 18-25) and that it would have been obvious to one with ordinary skill in the art to include a fee charged responsive to a device enabled to communicate with a network because Laybourn teaches such is conventional in the wireless art (Column 1, lines 20-1).

Appellants disagree. Laybourn discusses that subscribers of wireless phone services pay a monthly subscriber fee for access to a wireless service (Column 1, lines 18-22). Laybourn does not disclose or suggest an automated banking machine and does not disclose or suggest wireless communication between an automated banking machine and a portable wireless device. Also, as discussed previously, Pare does not disclose or suggest an ATM which communicates wirelessly or otherwise with a portable wireless device. Thus, how can it be obvious to one with ordinary skill in the art to include subscriber fees for wireless phone service from Laybourn in the ATM of Pare, when Pare does not teach or suggest the need to provide wireless services to a phone or any other portable wireless device from an ATM?

Nowhere in the applied art of Pare, Fisher, and Laybourn is there discloses or suggested a computer in an automated banking machine which receives a wireless communication signal from a portable wireless device. Further, nowhere in the applied rare is there disclosed or suggested sending through operation of the automated banking machine a wireless communication signal to the portable wireless device.

Further, Pare, Fisher, and Laybourn do not disclose or suggest:

- receiving through operation of the banking machine at least one third wireless communication signal from the portable wireless device, wherein the at least one third wireless communication signal includes data representative of a financial account;

- validating through operation of the banking machine that the account is authorized to accept a charge of a usage fee; and
- charging the usage fee to the account responsive to operation of the machine.

Appellants respectfully submit that the Office has not established *prima facie* obviousness. Pare, Fisher and Laybourn do not disclose or suggest each and every element, relationship and step of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Nor has the Office cited any other prior art which shows the features and relationships missing from Pare, Fisher, and Laybourn. Nor is there any prior art teaching, suggestion, or motivation cited for modifying Pare in view of Fischer and Laybourn so as to produce the claimed invention. Further, it would not have been obvious to one having ordinary skill in the art to have modified Pare, Fisher, and Laybourn to have produced the claimed invention. Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 2 is improper and should be withdrawn.

CONCLUSION

Each of Appellants' pending claims specifically recites elements, relationships, and steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied

prior art is devoid of any teaching, suggestion, or motivation for producing the recited invention.

For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



Ralph E. Jocke
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000

Reg. No. 31,029

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CLAIMS APPENDIX

1. A method comprising:
 - a) receiving with an automated banking machine at least one first wireless communication signal from a portable wireless device;
 - b) sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network;
 - c) receiving through operation of the banking machine at least one second network communication signal from the at least one server; and
 - d) sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal.
2. The method according to claim 1 further comprising:

- (e) receiving through operation of the banking machine at least one third wireless communication signal from the portable wireless device, wherein the at least one third wireless communication signal includes data representative of a financial account;
- (f) validating through operation of the banking machine that the account is authorized to accept a charge of a usage fee; and
- (g) charging the usage fee to the account responsive to operation of the machine.

3. The method according to claim 1 and further comprising:

dispensing cash from the automated banking machine.

4. The method according to claim 1 wherein the portable wireless device comprises a voice communication device.

5. The method according to claim 4 wherein the portable wireless device includes at least one memory including data representative of cash value, and further comprising modifying the data representative of cash value responsive to operation of the banking machine.

6. Computer readable media bearing instructions which are operative in at least one computer to cause the automated banking machine to carry out the method comprising:

- a) receiving with the automated banking machine at least one first wireless communication signal from a portable wireless device;
- b) sending through operation of the banking machine at least one first network communication signal corresponding to the at least one first wireless communication signal, to at least one server in operative connection with the banking machine through a wide area network;
- c) receiving through operation of the banking machine at least one second network communication signal from the at least one server; and
- d) sending through operation of the banking machine at least one second wireless communication signal to the portable wireless device corresponding to the at least one second network communication signal.

7. Apparatus comprising:

an automated banking machine including a computer;

at least one transaction function device in the machine and in operative connection with the computer; and

an external network interface in operative connection with the computer, wherein the external network interface enables the machine to communicate in a wide area network; and

a wireless access hub in operative connection with the computer, wherein the wireless hub enables the machine to communicate with at least one portable wireless device, wherein the machine is operative to enable the at least one portable wireless device to communicate in the wide area network.

8. The apparatus according to claim 7, wherein the at least one transaction function device includes a cash dispenser.

9. The apparatus according to claim 7, wherein the computer is adapted to receive information representative of an account from the at least one portable wireless device, and wherein responsive to the portable wireless device being enabled to communicate in the wide area network, the computer is operative to cause a fee to be charged to each account.

10. The apparatus according to claim 9, wherein the computer is adapted to communicate with a host banking system, wherein the computer is operative to cause the fee to be charged to the account through communication with the host banking system.

11. The apparatus according to claim 7 wherein the wide area network includes the Internet.

12. The apparatus according to claim 8 wherein the computer is operative to cause cash to be dispensed by the cash dispenser responsive to at least one input to the at least one portable wireless device.

13. The apparatus according to claim 7 and further comprising a portable wireless device including at least one data store, wherein the data store includes data representative of monetary value.

14. The apparatus according to claim 13 wherein the computer is operative to cause modification of the data representative of monetary value.

15. The apparatus according to claim 14 wherein the portable wireless device comprises a voice communication device.

16. The apparatus according to claim 7 wherein the wireless access hub is adapted to provide RF communication with the at least one portable wireless device.

17. The apparatus according to claim 16 wherein the wireless access hub enables RF communication over relatively short distance with the at least one portable wireless device.

18. A method comprising:

- a) providing, with an automated banking machine, a wireless network connection between a portable wireless device and the automated banking machine, wherein the automated banking machine includes a cash dispenser;
- b) providing, with the automated banking machine, a network connection between the automated banking machine and a public wide area network;
- c) determining with the automated banking machine that the portable wireless device is permitted to access the public wide area network;
- d) responsive to (c), providing with the automated banking machine, the portable wireless device with access to the public wide area network

through the wireless network connection with the automated banking machine.

19. The method according to claim 18, further comprising:

- e) receiving, with the automated banking machine, information corresponding to an account through the wireless network connection from the portable wireless device;
- f) causing, with the automated banking machine, a fee to be associated with the account for providing the portable wireless device with access to the public wide area network in (d).

20. The method according to claim 19, wherein in (d) the public wide area network includes the Internet.

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EVIDENCE APPENDIX

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Terms: english-claims ("1. a method comprising:") and granted-date is (2004) (Edit Search)

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1. 6836872, December 28, 2004, On-chip testing of integrated circuits, Abdennadher, Salem - Sacramento, California, 255155 (10), Intel Corporation, Santa Clara, California, 02

CORE TERMS: integrated, behavioral, filter, jitter, verification, analog, detect, computer, fault, mixed ...

December 28, 2004
... Top of Patent What is claimed is: **1. A method comprising:** inserting into a behavioral ...
2. 6836853, December 28, 2004, Non-volatile memory based monotonic counter, Dover, Lance W. - Fair Oaks, California; Gafken, Andrew H. - Folsom, California, 477034 (09), Intel Corporation, Santa Clara, California, 02

CORE TERMS: counter, monotonic, bit, non-volatile, memory, volatile, engine, programmed, processor, update ...

December 28, 2004
... Top of Patent What is claimed is: **1. A method comprising:** maintaining a first ...
3. 6836755, December 28, 2004, Method and apparatus for fully automated signal integrity analysis for domino circuitry, Nardin, Mark D. - Portland, Oregon; Greub, Hans - Cornelius, Oregon; Wijeratne, Sapumal - Portland, Oregon, 475717 (09), Intel Corporation, Santa Clara, California, 02

CORE TERMS: simulated, coupled, domino, conductor, circuitry, input, simulation, noise, gate, inverting ...

December 28, 2004
... Top of Patent What is claimed is: **1. A method comprising:** extracting parameters of a ...
4. 6836691, December 28, 2004, Method and apparatus for filtering metrology data based on collection purpose, Stirton, James B. - Austin, Texas, 427620 (10), Advanced Micro Devices, Inc., Austin, Texas, 02

CORE TERMS: metrology, fault, collection, process control, processing, wafer, controller, collected, monitor, manufacturing ...

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RELATED PROCEEDINGS APPENDIX

(None)